REMARKS

Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in view of the remarks contained herein. Claim 19 has been amended. Claims 1-25 are pending in this application.

Rejection under 35 U.S.C. § 103 (Gao in view of Monday)

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,581,094 to Gao (hereinafter, "Gao") in view of U.S. Patent No. 6,480,860 to Monday et al. (hereinafter, "Monday").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not satisfy the first or third criteria.

Lack of all Claim Limitations

Claim 1 requires transporting the defined data from the at least one host system to the storage management system via a remote procedure call. The Examiner has taken the position that Monday teaches this limitation, and Gao is not relied upon as teaching this limitation. Applicant respectfully disagrees with the Examiner's characterizations of Monday, and the assertion that Monday describes transporting the defined data...via a remote procedure call.

The Examiner has stated that Monday teaches the use of remote procedure calls using XML, and has cited col. 5, line 58, col. 5, lines 25-31, col. 7, lines 21-67, col. 8, lines 29-46, and points to col. 8, lines 29-46, specifically "XML translator 226". Applicant respectfully disagrees that the cited portions of Monday describe transporting the defined data from the at least one host system to the storage management system via a remote procedure call. The

cited portion of Monday instead describes XML translation functions as evidenced by the Examiner's reference to XML translator 226. See col. 5, lines 26-28, col. 8, lines 34-37. Nowhere in the portions of Monday cited by the Examiner is any reference made to remote procedure calls.

As further evidence that the portions of Monday cited by the Examiner do not refer to remote procedure calls, much less transporting the defined data from the at least one host system to the storage management system via a remote procedure call, Monday describes using remote procedure calls, not for transporting the defined data, but for cooperative processing amongst network devices. Column 6, lines 46-58.

Monday's XML translation functions cannot be equated to transporting the defined data from the at least one host system to the storage management system via a remote procedure call as required by claim 1, and Gao is not relied upon as teaching this function. As the combination put forth by the Examiner does not teach at least this limitation, Applicant respectfully requests the rejection of claim 1 based on the combination of Gao and Monday be withdrawn.

Lack of Motivation

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner has stated that it would have been obvious to improve upon the system taught by Gao by implementing the improvements detailed in Monday, because it would provide Gao's system with the enhanced capability of reducing server load and increasing programmer control over "how XML requests are processed and returned", citing Monday col. 8, lines 39-46. As set forth above, the Examiner is again using portions of Monday that describe XML translation functions, not transporting defined data as required by claim 1. The complete quote cited by the Examiner, but omitted from the action states: "Another benefit of placing XML translator 226 within a data access component (such as JavaBean) is that the programmer now has control over how XML requests are processed and returned." It is clear that the Examiner is referencing XML translation functions that have no relation to

transporting the defined data from the at least one host system to the storage management system via a remote procedure call. Claim 1 does not require XML translation in any way.

As Monday does not teach the motivation cited by the Examiner for combining Monday with Gao, and Monday's only reference to remote procedure call is to "engage in cooperative processing" (col. 6, lines 52-58), not transporting defined data, Applicant respectfully asserts that there is no motivation to combine Monday with Gao as required by *In re Mills*.

Claims 2-4 depend from claim 1, and therefore inherit all the limitations thereof. For at least the reasons set forth above claims 2-4 are allowable over the combination of Gao and Monday.

Rejection under 35 U.S.C. § 103 (Gao in view of Humpleman)

Claims 1-4, 7, 8, and 11-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view of U.S. Patent No. 6,466,971 to Humpleman et al. (hereinafter, "Humpleman").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second or third criteria, Applicant asserts that the rejection does not satisfy the first criteria.

Lack of Motivation

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner has stated that it would have been obvious to combine Humpleman with Gao to improve on the system taught by Gao by implementing the improvements detailed in Humpleman because it would "provide Gao's system with the enhanced capability of allowing the use of different XML RPC formats without changing the other aspects of the device to device control architecture", citing Humpleman col. 16, lines 30-35.

The Examiner's motivation to combine Humpleman with Gao is flawed in at least two respects. First, the Examiner's motivation states that the combination would allow Gao "the use of different XML RPC formats". By the Examiner's own admission in making the combination, Gao does not use remote procedure calls, or RPCs. Since Gao does not use RPCs it would be of no benefit to allow Gao to "use different XML RPC formats" as claimed by the Examiner. Second, the purpose of allowing the different XML RPC formats is to not require changing of the device to device control architecture. Gao does not have a device-to-device control architecture. Gao merely allows digital devices to share information on attributes and capabilities across a network using Uniform Device Descriptor files. Gao, Abstract. The purpose of Humpleman's XML RPCs is to allow custom controller modules in different devices to interoperate. See, Figure 19 of Humpleman, and the associated description at column 18.

As Gao does not use RPCs and does not have any device-to-device control architecture, the Examiner's stated motivation is fundamentally flawed. Since, for the reasons set forth above, there is no motivation to combine Gao and Humpleman, Applicant respectfully requests that the rejection of claims 1-4, 7, 8, and 11-18 based on the combination of Gao and Humpleman be withdrawn.

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view of Humpleman, and further in view of U.S. Patent No. 6,487,607 to Wollrath et al. (hereinafter, "Wollrath"). Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view of Humpleman, and further in view of Monday.

For the reasons set forth above, the combinations of Gao with Humpleman and Gao with Monday are improper for a lack of motivation as set forth in *In re Mills*. As there is no

motivation to combine the references, Applicant requests that the rejections of claims 5, 6, 9 and 10 be withdrawn.

Rejection under 35 U.S.C. § 102 (Gao)

Claims 19, 20 and 22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gao.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy these requirements.

Claim 19, as amended, requires remote procedure call means for transporting said obtained information from said defining means for further processing. At least this limitation is not shown in Gao. The Examiner has explicitly stated in the Office Action that Gao does not teach remote procedure calls. See, rejection of claim 1, pages 3 and 5. As Gao does not teach remote procedure calls, Gao cannot show a remote procedure call means for transporting said obtained information from said defining means for further processing, as required by claim 19. Applicant would therefore request that the rejection of claim 19 be withdrawn.

Claim 20 and 22 depend directly from claim 19, and therefore inherit all the limitations thereof. For at least the reasons set forth above, claims 20 and 22 are allowable over Gao.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view Woolrath. Claim 21 depends directly from claim 19. As claim 19 is allowable for the

reasons set forth above, claim 21 is allowable at least as depending from an allowable base claim.

Rejection under 35 U.S.C. § 103, Gao in view of Humpleman

Claims 23 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view of Humpleman.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the rejection does not, satisfy the first or third criteria.

Lack of all Claim Limitations

Claim 23 requires that the at least one host agent process is operable to define device discovery information in a markup language format and transport the formatted discovery information to the storage management system via a remote procedure call. The Examiner has pointed to the software agents designated Tool A and Tool B described in column 13 of Humpleman as corresponding to the host agent process of claim 23. Other than pointing to the software agents of Humpleman, the Examiner has not pointed to anything in Humpleman that corresponds to the requirement that the host agent process be operable to define device discovery information and transport the formatted discovery information to the storage management system via a remote procedure call, and Applicant can find no description in Humpleman that the software agents have any such capabilities.

Moreover, the software agents referenced in the Examiner's rejection have no relationship to the remote procedure calls referenced by the Examiner in the rejection of claim 1. The Examiner seems to have merely pointed to similar terms in Humpleman while ignoring the specific limitations set forth in claim 23. As Humpleman does not disclose at least one host agent process operable to define device discovery information in a markup

language format and transport the formatted discovery information to the storage management system via a remote procedure call, and Gao is not relied upon as teaching this limitation, Applicant respectfully submits that claim 23 is allowable over the combination of Gao and Humpleman.

Lack of Motivation

It is well established that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner has stated that it would have been obvious to combine Humpleman with Gao to improve on the system taught by Gao by implementing the improvements detailed in Humpleman because it would "provide Gao's system with the enhanced capability of using a definition and interface data type to create an XML document", citing col. 13, lines 12-20 and 51-63. The Examiner, however, fails to state how and why Gao would use a "definition and interface data type to create an XML document". Gao implements its UDD files as XML documents and has extensively described a mechanism to create, share and utilize the UDD files amongst its devices. There is no indication in Gao as to the need for a "definition and interface data type to create an XML document", in as far as Applicant understands the phrase.

For the reasons set forth above, there is no motivation to combine Humpleman with Gao as required by *In re Mills*, and Applicant respectfully requests that the Examiner withdraw the rejection of claim 23 based on this combination.

Claim 24 depends from claim 23, and therefore inherits all the limitations thereof. For at least the reasons set forth above, claim 24 is allowable over the combination of Gao and Humpleman.

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Gao in view of Humpleman, and further in view of Wollrath. Claim 25 depends from claim 23 and inherits all the limitations thereof. As claim 23 is in condition for allowance for the reasons set forth above, claim 25 is allowable at least as depending from an

allowable base claim. Further, for the reasons set forth above, the combinations of Gao with Humpleman and Gao with Monday are improper for a lack of motivation as set forth in *In re Mills*. As there is no motivation to combine the references, Applicant requests that the rejection of claim 25 be withdrawn.

Conclusion

In view of the foregoing remarks, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10004551-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482708695US in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313.

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